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PATENT  
Attorney Docket No. 05725.1011-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Daniela GIACCHETTI ) Group Art Unit: 3628  
)  
Application No.: 10/024,482 ) Examiner: Igor N. Borissov  
)  
Filed: December 21, 2001 )  
) Confirmation No.: 4566  
For: BODY IMAGE TEMPLATES WITH )  
PRE-APPLIED BEAUTY )  
PRODUCTS )

**Mail Stop Appeal Brief--Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)**

Transmitted herewith is the APPEAL BRIEF in this application with respect to the  
Notice of Appeal filed on March 14, 2007.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

**TOTAL FEE DUE:**

Appeal Brief Fee \$500.00

Extension Fee (if any) \$0

Total Fee Due \$500.00

☒ Enclosed is a check for \$500.00 to cover the above fee.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account 06-0916.

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 10, 2007

By: 

Jeremy T. Thissell  
Reg. No. 56,065



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Commissioner for Patents  
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Sir:

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

In support of the Notice of Appeal filed March 14, 2007, and in accordance with 37 C.F.R. § 41.37, Appellant presents this brief and encloses herewith a check for the fee of \$500.00 required under 37 C.F.R. § 41.20(b)(2).

This Appeal relates to the December 14, 2006, final Office Action in which claims 1-21 were rejected.

If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account 06-0916.

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## **I. Real Party In Interest**

L'Oréal SA is the real party in interest.

## **II. Related Appeals and Interferences**

There are currently no other appeals or interferences, of which Appellant, Appellant's legal representative, or assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. Status of Claims**

Claims 1-21 remain pending in this application. Claims 1 and 18 are independent. Claims 1-21 stand finally rejected. The rejections applied to these claims are at issue in this appeal.

#### **IV. Status of Amendments**

No amendments have been filed subsequent to the final rejection.

## **V. Summary of Claimed Subject Matter**

### **A. Independent Claim 1**

The subject matter set forth in independent claim 1 relates to a method of enabling display of a simulated facial image. Specification, page 35, line 14-page 37, line 2; Figs. 10A and 10C<sup>1</sup>. The method includes facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product. Page 35, line 14-page 37, line 19; Figs. 10A and 10C. The method also includes enabling selection of at least one of the displayed templates. Page 35, line 14-page 36, line 2; page 37, line 22-page 38, line 11; Figs. 10A and 10C. Further, the method includes facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template. Page 35, line 14-page 36, line 2; page 38, line 12-page 39, line 2.

### **B. Independent Claim 18**

The subject matter set forth in independent claim 18 relates to a method of enabling viewing display of a simulated facial image. Page 36, line 9-page 37, line 2; page 39, lines 15-23; Figs. 10B and 10C. The method includes viewing display, on a display device, of a plurality of templates, wherein at least some of the templates are

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<sup>1</sup> The references to the specification and drawings in this Appeal Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. These references are not necessarily exhaustive. Further, the references should not be construed as limiting the claims.

representative of a portion of a face having a simulation of use of a beauty product.

Page 36, line 9-page 37, line 19; page 39, lines 15-23; Figs. 10B and 10C. The method also includes selecting at least one of the displayed templates. Page 37, line 22-page 38, line 11; page 39, lines 15-23; Figs. 10B and 10C. Further, the method includes viewing display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template. Page 38, line 12-page 39, line 2; page 39, lines 15-23.

## **VI. Grounds of Rejection to be Reviewed on Appeal**

A. Claim 1 stands rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter.

B. Claims 1-11 and 13-21 stand rejected under 35 U.S.C. § 102(e) based on Orpaz et al. (U.S. Patent No. 6,937,755; hereinafter "Orpaz").

C. Claim 12 stands rejected under 35 U.S.C. § 103(a) based on Orpaz in view of Lambertsen (U.S. Patent Appl. No. 2002/0024528; hereinafter "Lambertsen").

## **VII. Argument**

### **A. The rejection of claim 1 under 35 U.S.C. § 101 should be reversed.**

On page 2 of the final Office Action, the Examiner asserts that claim 1 is purportedly “directed to non-statutory subject matter.” The Examiner alleges that claim 1 “appear[s] to be directed to nothing more than presenting information to a consumer.” Id. at 3. Appellant respectfully disagrees. According to the Federal Circuit, whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d at 1375. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. See State Street, 149 F.3d at 1373, AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358 (Fed. Circ. 1999), also cited in M.P.E.P. § 2106(II)(A).

Appellant respectfully submits that claim 1 is directed to statutory subject matter because claim 1 includes recitations that produce a “concrete, tangible and useful” result and, therefore, recites a practical application that is not abstract. Claim 1 relates to a method for enabling display of a simulated facial image and recites features that clearly produce a useful, concrete, and tangible result. For example, in claim 1, the recitations of “facilitating display . . . of a plurality of templates,” “enabling selection of at least one of the displayed templates,” and “facilitating display . . . of a simulated facial image,” provide a useful, concrete, and tangible result in the form of, for example, a simulated facial image that includes one or more displayed facial portions having a simulation of use of a beauty product. This is a result that can be used in beauty analysis. Specification at 3.

Further, the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” issued on October 26, 2005, indicate, “[i]n determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is “useful, tangible and concrete.” In this application, for example, “facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product,” as recited in claim 1, is undeniably useful, and constitutes a tangible and concrete final result. Further, such a result facilitates display of a simulated facial image and enables a beauty analysis.

In the Office Action, the Examiner asserts that “[t]he method step of: ‘enabling selection of at least one of the displayed templates’ does not require the actual selection step to be performed, and, as such, does not guarantee the displaying step.” Office Action at 3. Based on this assertion, the Examiner concludes that “the method as a whole, does not produce a tangible [sic], useful and repeatable result.” *Id.* The Examiner further applies the “[s]ame reasoning . . . to the step of: ‘facilitating display’” and alleges that it “does not require the displaying step to be performed.” *Id.*

The Examiner has apparently misconstrued claim 1. For example, the Examiner makes reference to “the actual selection step” and “the displaying step,” but apparently fails to appreciate that claim 1 recites “enabling selection . . .” and “facilitating display . . .,” not a “selection step” or a “displaying step.” *Id.* Accordingly, the final Office Action fails to set forth a *prima facie* basis for the claim rejection under 35 U.S.C. § 101.

For at least the foregoing reasons, Appellant respectfully submits that claim 1 is statutory under 35 U.S.C. § 101 and thus, the rejection of claim 1 under 35 U.S.C. § 101 should be reversed.

**B. The rejection of claims 1-11 and 13-21 under 35 U.S.C. § 102(e) should be reversed.**

Appellant submits that the rejection of claims 1-11 and 13-21 under 35 U.S.C. § 102(e) based on Orpaz should be reversed. In order for Orpaz to anticipate Appellant's claims under 35 U.S.C. § 102(e), each and every element of the claims at issue must be found, either expressly or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)).

Orpaz fails to anticipate independent claims 1 and 18 because Orpaz does not disclose, expressly or otherwise, each and every feature recited in claims 1 and 18. For example, Orpaz does not disclose "facilitating display, on a display device, of a plurality of templates . . . ; enabling selection of at least one of the displayed templates; and facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template," as recited in claim 1. Further, Orpaz does not disclose "viewing display, on a display device, of a plurality of templates . . . ; selecting at least one of the displayed templates; and viewing display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty

product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template,” as recited in claim 18.

With regard to independent claims 1 and 18, the Examiner cites Orpaz at Figs. 12-18; column 6, lines 20-41 and 61-65; and column 6, line 66 through column 7, line 13 for the asserted disclosure of certain subject matter. Final Office Action at 4. The Examiner has apparently attempted to equate Figs. 12-18, which are the alpha values for various make-up application areas, with the “templates” recited in claims 1 and 18. Id. However, the Examiner’s reasoning is flawed. For example, with respect to claim 1, Orpaz does not disclose facilitating display of the images of Figs. 12-18 or enabling selection of any of those images. And, regarding claim 18, Orpaz does not disclose viewing the images of Figs. 12-18 or selecting any of those images. Rather, the images shown in Figs. 12-18 are representations of “alpha values” or “alpha channels” each of which is “a pixel-by-pixel map representing where and how much of an associated make-up product should be placed within [a] base image.” Col. 6, lines 2-4.

As described in detail in Orpaz at col. 5, line 66-col. 6, line 41, the alpha values are not displayed templates from which to choose, but rather electronic tools used to determine the amount of a chosen make-up color that is to be applied to each portion of a base image (i.e., in order to depict a blended application of the particular make-up). Figs. 12-18 are merely presented as images in Orpaz “for explanatory purposes” and depict alpha values in “gray-scale images reflecting the alpha values for associated pixels in the base image.” Col. 6, lines 20-23. Therefore, the alpha values are not templates, but are rather numerical values between zero and 255 that are assigned to

each pixel, whereby a lower alpha value associated with a given pixel indicates that more of a chosen make-up color should be applied to that pixel. Col. 6, lines 4-19. The images depicted in Figs. 12-18 are not any kind of template displayed or viewed during use of the Orpaz system, but rather a visual aid in the Orpaz patent to facilitate explaining the meaning of alpha values.

In the Orpaz system, a user selects a product from a database using an image simulation interface. Col. 6, lines 61-63. "To simulate the appearance of the selected product on the base image of the user, the color information of the selected product is modified and blended according to the color information of the base image to create a composite image." Col. 6, line 66 - col. 7, line 3. For each base image, one or more make-up application areas are defined for each make-up product type and are assigned a separate alpha channel within the base image file. Col. 5, line 66-Col. 6, line 2.

Contrary to the Examiner's apparent assertions, the portions of Orpaz cited by the Examiner relate to a user selecting a product and simulating the appearance of the product. Nothing in Orpaz discloses, e.g., "facilitating display . . . of a plurality of templates . . .; enabling selection of at least one of the displayed templates; and facilitating display . . . of a simulated facial image including at least one displayed facial portion . . . wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template," as recited in claim 1. For example, Orpaz does not have any disclosure relating to facilitating display of any of Figs. 12-18 or enabling selection of one or more of Figs. 12-18. Therefore, Orpaz et al. does not disclose each and every element of claim 1.

Moreover, Orpaz also fails to disclose each and every feature of claim 18. In particular, Orpaz does not disclose “viewing display . . . of a plurality of templates . . . ; selecting at least one of the displayed templates; and viewing display . . . of a simulated facial image including at least one displayed facial portion . . . wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template,” as recited in claim 18.

For at least the foregoing reasons, Appellant respectfully submits that the 35 U.S.C. § 102(e) rejection of independent claims 1 and 18 and dependent claims 2-11, 13-17, and 19-21 should be reversed.

**C. The rejection of claim 12 under 35 U.S.C. § 103(a) should be reversed.**

Appellant submits that the rejection of claim 12 under 35 U.S.C. § 103(a) based on Orpaz in view of Lambertsen should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Here, the cited references cannot support a rejection under 35 U.S.C. § 103(a) because, among other things, Orpaz and Lambertsen, taken alone or in any proper combination, do not disclose or suggest each and every feature recited in Appellant's claim 1, from which claim 12 depends.

In particular, Lambertsen does not overcome the above-noted shortcomings of Orpaz. For example, Lambertsen does not disclose or suggest “facilitating display, on a display device, of a plurality of templates . . . ; enabling selection of at least one of the displayed templates; and facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template,” as recited in claim 1. Nor does the Examiner assert that Lambertsen discloses such features. Accordingly, Orpaz and Lambertsen, taken alone or in any proper combination, do not disclose or suggest each and every feature recited in Appellant’s independent claim 1, from which claim 12 depends. Therefore, at least one essential requirement for establishing a prima facie case of obviousness is lacking and, for at least this reason, the § 103(a) rejection of claim 12 should be reversed.

The Examiner cites Lambertsen solely for the asserted disclosure of “selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eyebrows.” Final Office Action at 7. However, Lambertsen fails to disclose or suggest even this feature. The Examiner cites Fig. 4 and paragraphs [0010] and [0011], alleging that Lambertsen teaches that “various portion [sic] of a facial image including a head, eyes, nose, lips, ears, and eye brows are provided with a default shape, [and that] said default shape can be changed (reshaped) by the user.”

This allegation is inaccurate, however, because Lambertsen does not disclose that various portions of the facial image can be changed, but rather discloses that “outlines” superimposed on the image can be changed. Paragraph [0010], lines 3-5;

paragraph [0011], lines 7-9. The outlines can be altered to delineate the area in which a make-up color selected by a user will be applied to the underlying image. Paragraph [0012]. Therefore, contrary to the Examiner's allegation, Lambertsen does not disclose or suggest "enabling selection of at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows," as recited in claim 12.

Accordingly, because neither Orpaz, nor Lambertsen, nor any proper combination thereof, discloses or suggests each and every feature recited in claim 12, the rejection of claim 12 under 35 U.S.C. § 103(a) should be reversed.

#### **D. Conclusion**

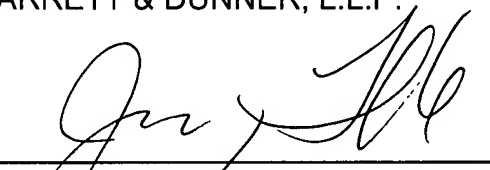
For at least the reasons given above, Appellant respectfully submits that the rejections under 35 U.S.C. §§ 101, 102(e), and 103(a) should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 10, 2007

By:   
\_\_\_\_\_  
Jeremy T. Thissell  
Reg. No. 56,065

**VIII. Claims Appendix**

1. A method of enabling display of a simulated facial image, the method comprising:  
facilitating display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product;  
enabling selection of at least one of the displayed templates; and  
facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion having a simulation of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.
2. The method of claim 1, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion along with a simulation of a differing beauty product.
3. The method of claim 2, wherein the beauty product comprises make-up, and wherein each template in the group of templates has a simulation of a differing make-up.
4. The method of claim 3, wherein each template in the group has a simulation of make-up with at least one of a differing color, a differing texture, a differing brand, and a differing formulation.
5. The method of claim 1, wherein the plurality of templates comprise a group of templates each having a different shaped facial portion.

6. The method of claim 1, wherein the facial portion is chosen from lips, eyes, cheeks, and eyebrows.
7. The method of claim 1, wherein the beauty product comprises make-up.
8. The method of claim 1, wherein the simulated facial image is one of two-dimensional image and a three-dimensional image.
9. The method of claim 1, wherein the simulated facial image is displayed on a simulated likeness of at least a portion of a human.
10. The method of claim 9, further comprising enabling selection of at least one article of clothing, wherein the selected article of clothing is displayed on the simulated likeness.
11. The method of claim 1, wherein at least one of facilitating display of a plurality of templates, enabling selection of at least one of the displayed templates, and facilitating display of a simulated facial image comprises providing access to software.
12. The method of claim 1, further comprising enabling selection of at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows.
13. The method of claim 1, further comprising enabling application of coloration to the simulated facial image to simulate at least one of actual skin tone and actual hair color.
14. The method of claim 1, wherein the beauty product comprises a cosmetic product chosen from mascaras, eye shadows, eye liners, foundations, concealers, blushers, lip make-ups, lip sticks, lip glosses, and hair colorings.

15. The method of claim 1, further comprising enabling storage of the simulated facial image for selective recall by an individual.

16. A computer-readable medium containing instructions for the method of claim 1.

17. A system comprising a processor configured to perform the method of claim 1.

18. A method of enabling viewing display of a simulated facial image, the method comprising:

viewing display, on a display device, of a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product;

selecting at least one of the displayed templates; and

viewing display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.

19. The method of claim 18, wherein the beauty product comprises make-up.

20. The method of claim 1, wherein facilitating display of the plurality of templates comprises displaying, on the display device, the plurality of templates, wherein enabling selection comprises selecting at least one of the displayed templates, and wherein facilitating display of the simulated facial image comprises displaying, on the display device, the simulated facial image.

21. The method of claim 18, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion along with a simulation of a differing beauty product.

**IX. Evidence Appendix**

There is no evidence being relied upon by appellant in this appeal.

Application No.: 10/024,482  
Attorney Docket No.: 05725.1011-00000

**X. Related Proceedings Appendix**

There are no decisions from related proceedings.